



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/665,298	10/31/2012	James K. Noble JR.	P2012-20	9940
103720	7590	07/17/2014	EXAMINER	
Noble Systems Corporation Attn: Karl Koster 1200 Ashford Parkway Suite 300 Atlanta, GA 30338-4747			SINGH, GURKANWALJIT	
			ART UNIT	PAPER NUMBER
			3623	
			NOTIFICATION DATE	DELIVERY MODE
			07/17/2014	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kkoster@noblesystems.com
chaggerty@noblesys.com
noblepatent@gmail.com

DETAILED ACTION

1. This non-final Office action is in response to applicant's communication received on October 31, 2012, wherein **claims 1-18** are currently pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based upon consideration of all of the relevant factors with respect to **claims 1-18 as a whole**, the claims are directed to abstract idea and are therefore rejected as ineligible subject matter under 35 U.S.C. § 101.

Further, while the claim(s) recite(s) hardware or software elements, such as processors or modules or computer readable mediums, these limitations are not enough to qualify as "significantly more" being recited in the claim along with the abstract idea. Therefore, since there are no limitations in the claim that transform the exception into a patent eligible application such that the claim amounts to significantly more than the exception itself, the claim is rejected under 35 USC § 101 as being directed to non-statutory subject matter.

Art Unit: 3623

In addition to the above §101 reasoning, Claims 13-18 are also drawn to a computer program per se. Computer programs per se intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs per se are not considered to be statutory subject matter.

Claims 13-18 recite a system comprising a plurality of modules to perform a plurality of steps. These recitations amount to mere data structures as they do not positively recite any structural components of the system in the body of the claim, and therefore could merely comprise the program/software code or modules for performing the steps of the invention. Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. See MPEP 2106.01 (I). Hence claims 13-18 are drawn to a computer program per se. A machine (type of product) is a concrete thing, consisting of parts, or of certain devices and combination of devices. This includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. A claim that includes terms that imply that the invention is directed to a product, for instance by reciting "a machine comprising...", but fails to include tangible structural elements or limitations under the broadest reasonable interpretation is not limited to a practical application, but rather wholly embraces or encompasses the concept upon which the invention is based. This is impermissible as such claim coverage would extend to every way of applying the abstract idea, law of nature or

Art Unit: 3623

natural phenomenon. Thus, such a claim is therefore non eligible subject matter. Furthermore, Examiner notes that when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory. See MPEP 2106.10(I). For this reason, computer programs *per se* intrinsically require no tangible physical structure, and so do not constitute tangible physical articles or other forms of matter. Therefore, computer programs *per se* are not considered to be statutory subject matter.

In addition to the above reasons for rejection, Claims 7-12 are also rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter because Applicant has claimed a computer readable medium which could reasonably comprise a transitory propagating signal *per se*. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989). The broadest reasonable interpretation of a claim drawn to a computer readable medium typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. Here, Applicant has claimed a computer readable medium, and the specification is silent on whether this medium is explicitly non-transitory medium. Therefore, given the broadest reasonable interpretation of the claim, the recited computer readable medium could be interpreted as a transitory propagating signal *per*

Art Unit: 3623

se. As such, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007).

In order to overcome this rejection under 35 U.S.C. 101, a claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments by adding the limitation "non-transitory" to the claim. *Cf Animals - Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multicellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gurkanwaljit Singh whose telephone number is (571)270-5392. The examiner can normally be reached on Monday to Thursday 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gurkanwaljit Singh/
Primary Examiner, Art Unit 3623